



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,858	12/14/2001	Stephen Schleicher	60119-0011	7128

29989 7590 11/01/2007
HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT	PAPER NUMBER
----------	--------------

3693

MAIL DATE	DELIVERY MODE
-----------	---------------

11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/017,858	Applicant(s) SCHLEICHER, STEPHEN	
	Examiner Kirsten S. Apple	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the applicants RCE filed on 8/10/07.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission has been entered.

Claim Rejections - 35 USC § 102

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-56 under 35 USC 102.

The Applicant attention is re-drawn to the following:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Ewald (US Patent Publication 2003/0014384).

Re claim 1 & 12: Ewald discloses:

A method & system for exchanging documents in a hub (see Ewald, abstract), comprising:

Storing an agreement associated with each document type for each partner that joins the exchange network, each agreement defines one or more rules about the data format in which the respective partner sends and receives documents of the document type (see Ewald, Figure 2, item 36)

Placing file in receiving location – password protected (see Ewald, Figure 2, item 38)

Retrieving document(see Ewald, Figure 2, item 54)

Validating document against respective agreement(see Ewald, Figure 2, item 56)

Mapping document format (see Ewald, Paragraph 15, “independent of content and format” – it is inherent it would need to map as necessary different formats to make it “independent”)

Assigning a key to document for future reference (see Ewald, Figure 2, item 38)

Processing the document based on agreement – rules of hub entity and rules of first partner (see Ewald, Figure 2, item 102, 106 & 108)

Mapping document into altered format and sending to second partner based on agreement (see Ewald, Paragraph 15, “independent of content and format” – it is inherent it would need to map as necessary different formats to make it “independent”)

Re claim 2 & 13: Ewald discloses:

Art Unit: 3693

Agreement defines business rules – how to send, receive and format (see Ewald, Figure 2, item 102, 106 & 108)

Re claim 3 & 14: Ewald discloses:

Key is unique to document and set along with document (see Ewald, Figure 2, item 38)

Re claim 4 & 15: Ewald discloses:

Standard format is more flexible format, common rules (see Ewald, Paragraph 15)

Re claim 5 & 16: Ewald discloses:

Common process based on agreement (see Ewald, Paragraph 15)

Re claim 6 & 17: Ewald discloses:

Setting up the agreement involved creating a document-mapping between a partner's native format and the standard format (see Ewald, Paragraph 15)

Re claim 7 & 18: Ewald discloses:

Previously joined partners need not duplicate mapping (see Ewald, Paragraph 15)

Re claim 8 & 19: Ewald discloses:

Mapping to and from is document-type-specific (see Ewald, Paragraph 15)

Re claim 9 & 20: Ewald discloses:

Document-mapping is created by using a graphical tool in a drag-and-drop fashion

(see Ewald, Figure 9)

Re claim 10 & 21: Ewald discloses:

Once created documents are stored in a database (see Ewald, Figure 1, Item 12)

Re claim 11 & 22: Ewald discloses:

Process is different by partner's business rules and policies (see Ewald, Figure 2, item 102, 106 & 108)

Re claim 23-56

The claims 23-56 are similar to claims 1-22 except that 1-22 refer to 2 partners while 23-56 refer to partners specific to a supply chain where the document is being purchased. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claims 23-56 are rejected based on the information provided regarding claims 1-22.

Response to Arguments

Applicant's arguments filed 12/18/06 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued that in claim one the "documents are transformed from one partner's native formation to another partner's native format." The applicant claims that the reference Ewald does not teach this.

The Examiner refutes the argument made by the Applicant and draws the attention to Ewald, Figure 2, item 36 as well as paragraph 0038 –0042. There are a few specific lines that should be highlighted including "semi-structured document in XML form" (paragraph 0038, line 3). To clearly understand the process it is first important to understand XML.

The examiner would like to again (see Final office 3/21/07) point the applicant to the definition of XML from wikipedia: "The Extensible Markup Language (XML) is a W3C-recommended general-purpose markup language that supports a wide variety of applications. XML languages or 'dialects' may be designed by anyone and may be processed by conforming software. XML is also designed to be reasonably human-legible, and to this end, terseness was not considered essential in its structure. XML is a simplified subset of Standard Generalized Markup Language (SGML). Its primary purpose is to **facilitate the sharing of data across different information systems**, particularly systems connected via the Internet[1]. Formally defined languages based on XML (such as RSS, MathML, GraphML, XHTML, Scalable Vector Graphics, MusicXML and thousands of other examples) allow diverse software to reliably understand information formatted and passed in these languages."

Secondly it is important to point out "searches for documents in any format" paragraph 0042, line 7-8. Which make it clear that not all of the users are using the same format.

Third it is important to point out "extract from all retrieved capsules" and "forward to second party interface program" (paragraph 0041).

While Ewald does not use the word "transform" it is clear from the description that the "document of different formats" are searched and sent to the interface with XML a language for sharing data. It is clear from this description that documents of different formats are searched and transformed from one format to another format.

Furthermore, should the applicant be unsatisfied with the above argument the examiner would argue that the format type of the document is simply a matter of design choice.

Conclusion

This is a continuation of applicant's earlier Application No.10/017,858. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa


ELLA COLBERT
PRIMARY EXAMINER